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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77320532
Applicant	The Enkeboll Co.
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Case No.: ENKEB-858T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	THE ENKEBOLL CO.)	Law Office:	117
)		
Serial No.:	77/320,532)	Examining Attorney:	
)		Amos T. Matthews
Filed:	November 2, 2007)		
)		
Mark:	THE FINEST ARCHITECTURAL)		
	WOODCARVINGS IN THE WORLD)		
)		

APPELLANT'S REPLY BRIEF ON EX PARTE APPEAL

Assistant Commissioner for Trademarks
Post Office Box 1451
Alexandria, Virginia 22313-1451

Dear Sir/Madam:

Appellant respectfully submits the following in support of registration of its mark.

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I. INTRODUCTION

The following is responsive to the Examining Attorney's Appeal Brief dated February 10, 2009.

Appellant appealed to the Trademark Trial and Appeal Board from the Examining Attorney's Final Office Action. The Examining Attorney refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), contending that the Proposed Mark "THE FINEST ARCHITECTURAL WOODCARVINGS IN THE WORLD" describes a feature of Appellant's services. Appellant filed an Appeal Brief on December 9, 2008 and submitted arguments contending that the Proposed Mark is not merely descriptive because the Proposed Mark does not include laudatory language, nor does the Proposed Mark immediately convey knowledge of Appellant's advertising and promotional services.

In response to Appellant's Appeal Brief, the Examining Attorney filed a responsive Examining Attorney's Appeal Brief on February 10, 2009. As set forth in the following sections of this Reply Brief, Appellant respectfully submits that the Examining Attorney's contentions made in the Examining Attorney's Appeal Brief are in error and requests that this Board reverse the Examining Attorney's refusal to register the Proposed Mark under Trademark Act Section 2(e)(1) and pass the Proposed Mark to publication.

II. RECITATION OF THE FACTS

As previously stated in Appellant's Appeal Brief, Appellant filed its application to register the Proposed Mark "THE FINEST ARCHITECTURAL WOODCARVINGS IN THE WORLD" on November 2, 2007 under 15 U.S.C. Section 1051(b). The application was filed in

relation to goods in International Class 035, specifically, “[a]dvertising and promotional services pertaining to architectural woodcarving products.”

On February 19, 2008, the Examining Attorney rendered an Initial Office Action stating that registration of the Proposed Mark was refused under Trademark Act Section 2(e)(1), because the Proposed Mark merely describes a feature of Appellant’s services. The Examining Attorney also required a signed declaration.

Appellant filed a response to the Initial Office Action on May 6, 2008. In that communication, Appellant argued that the mark is not merely descriptive for the identified services. In addition, Appellant submitted a signed declaration, as requested by the Examining Attorney.

The Examining Attorney mailed a second Office Action to Appellant on June 20, 2008 maintaining the refusal to register the Proposed Mark under Trademark Act Section 2(e)(1) and made such refusal final.

In response to the second Office Action, Appellant filed a Notice of Appeal on November 18, 2008, and a corresponding Appeal Brief on December 9, 2008.

The Examining Attorney filed an Examining Attorney’s Appeal Brief on February 10, 2009. Accordingly, the present Reply Brief herein is timely filed. For the reasons detailed below and for the reasons set forth in Appellant’s Appeal Brief and responses to the previous Office Actions, Appellant submits that the Proposed Mark is entitled to registration.

III. LEGAL STANDARDS FOR DETERMINING DESCRIPTIVENESS

In order for a mark to be deemed merely descriptive under Trademark Act Section 2(e)(1), the United States Patent and Trademark Office bears the burden of establishing that the mark “*immediately convey[s]. . . knowledge of the ingredients, quality, or characteristics of*

goods . . . with which it is used."¹ See *In re Gyulay*, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987). However, where "*imagination, thought, or perception is required to reach a conclusion on the nature of the [services]*," a mark will not be determined to be merely descriptive of the goods or services. *In re Kwik-Print Copy Shop, Inc.*, 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980).

A mark must be evaluated for descriptiveness in relation to the identified goods or services, and not in the abstract. A mark can suggest the type of goods or services offered without being labeled "*merely descriptive*". See *In re DC Comics, Inc.*, 689 F.2d 1042, 1044, 215 U.S.P.Q. 394, 396 (C.C.P.A. 1982) (a descriptive term "*conveys to one who is unfamiliar with the product its functions or qualities*"); *In re Seats, Inc.*, 225 U.S.P.Q. 364 (Fed. Cir. 1985) (the mark SEATS for ticket reservation and issuing services for various events by means of a computer is not merely descriptive of the applicant's services, even though such services involve purchasing a ticket for a seat at various events); *Equine Technologies, Inc. v. Equitechnology, Inc.*, 36 U.S.P.Q.2d 1659 (1st Cir. 1995) (mark EQUINE TECHNOLOGIES is suggestive of hoof pads for horses, and is not merely descriptive, even though "U" in the shape of a horseshoe might suggest hooves or horseshoes to perceptive customers, but such mark does not convey information about the plaintiff's product or its intended customers and requires imagination to connect plaintiff's term to hoof care products and hoof pads for horses); *Hunting Hall of Fame Foundation v. Safari Club International*, 6 U.S.P.Q.2d 1765, 1770 (D. Ariz. 1987) (even if a mark suggests the type of goods involved, it is nonetheless registrable if consumers will view the mark as referring to the company and not the goods; it is a consumer's reaction to the mark at the time in question that is the test).

¹ For a more detailed explanation of the legal standard for determining descriptiveness, please see Appellant's Appeal Brief.

A mark may also be merely descriptive if the United States Patent and Trademark Office can establish that the mark is laudatory. T.M.E.P. § 1209.03(k). A mark is laudatory only if it attributes quality or excellence to the goods or services. *Id.*

Any doubt as to whether a mark is merely descriptive or suggestive must be resolved in favor of the trademark applicant by allowing publication of the mark for opposition. *See In re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972).

IV. APPELLANT’S MARK IS NOT MERELY DESCRIPTIVE OF APPELLANT’S SERVICES BECAUSE THE MARK DOES NOT HAVE A LAUDATORY CONNOTATION

In Appellant’s Appeal Brief, Appellant argued, *inter alia*, that the Proposed Mark is not merely descriptive because the word “finest” does not have a laudatory connotation as used in the Proposed Mark. Instead, Appellant submits that “finest” connotes “delicately fashioned,” which is a dictionary definition attached as Exhibit A in Appellant’s Appeal Brief. The connotation of a “delicately fashioned” wordcarving does not attribute quality or excellence to the goods or services, which is a requirement of a laudatory term. Instead, “delicately fashioned” conveys a level of care and detail taken during the preparation of the workcarving.

The Examining Attorney argues that “*descriptiveness is considered in relation to the relevant goods and/or services and the meaning imparted by the mark as a whole.*” Examining Attorney’s Appeal Brief, page 9. Appellant agrees with this assertion and submits that when used in the context of the Proposed Mark, which explicitly mentions “architectural woodcarvings,” the word “finest” connotes “delicately fashioned” rather than “surpassing in quality.”

The Examining Attorney additionally suggests that “[t]he fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness.” Examining Attorney’s Appeal Brief, page 9. However, Appellant submits that where there are numerous definitions or interpretations possible for a given term, this precludes a finding that such term can be merely descriptive under the Trademark Act. *See Henry Siegel Co. v. M & R International Mfg. Co.*, 4 U.S.P.Q.2d 1154 (T.T.A.B. 1987); *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382 (C.C.P.A. 1968); *In re National Tea Co.*, 144 U.S.P.Q. 286 (T.T.A.B. 1965); *In re Grand Metropolitan Foodservice, Inc.*, 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994). With regard to the Proposed Mark, Appellant submits that the term “finest” is interpreted to mean “delicately fashioned,” whereas the Examining Attorney submits that “finest” is interpreted to mean “surpassing in quality.” At the very least, the multiple definitions or interpretations precludes a finding that the Proposed Mark is merely descriptive.

The Examining Attorney also mentions that the term “finest” has previously been deemed laudatory by the Office. In support of this assertion, the Examining Attorney cites to specific marks where the Assistant Commissioner of Trademarks found that “finest” has a laudatory connotation. Appellant agrees that in some instances the term “finest” may have a laudatory connotation (though not in the Present Mark). Although the Examining Attorney offers individual instances where the term “finest” was found to be laudatory, it is important to note that the Examining Attorney does not appear to be suggesting that “finest” is always laudatory. Rather, each mark should be evaluated individually in relation to the related goods and services. Therefore, Appellant is not arguing that the term “finest” is never laudatory; rather, that “finest” is not always laudatory, especially when used in the Proposed Mark.

In addition to the foregoing, it is important to note that any doubt must be resolved in Appellant’s favor according to controlling case law authority. *In re The Rank Organization Ltd.*,

222 U.S.P.Q. 324, 326 (T.T.A.B. 1984). *In re The Nobele Company*, 225 U.S.P.Q. 749, 750 (T.T.A.B. 1980) ([I]f there was any doubt about whether the term ... is merely descriptive ... that doubt should be resolved in favor of the Appellant); *In re Mobile Ray Inc.*, 224 U.S.P.Q. 247, 248 (T.T.A.B. 1984) (“[W]hen there is doubt in the matter, the doubt should be resolved in Applicant’s behalf and the mark should be published for opposition”).

V. CONCLUSION

Appellant respectfully submits that the Proposed Mark is not merely descriptive. As such, the Examining Attorney’s refusal to register the Proposed Mark is inappropriate and cannot be sustained. Appellant hereby appeals to the Trademark Trial and Appeal Board from the final decision dated June 20, 2008, refusing registration of the Proposed Mark. Therefore, Appellant respectfully requests that the mark be passed to publication.

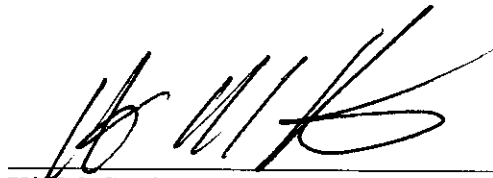
The Assistant Commissioner for Trademarks is hereby authorized to charge payment of any additional fees required or credit any overpayment of the same to Deposit Account No. 19-4330.

Respectfully submitted,

Date:

2/27/09

Customer No.: 007663



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